REMARKS/ARGUMENTS

The undersigned wishes to thank Examiner Nicholson for the courtesies extended in the interview conducted on April 26, 2007, with the undersigned. The following remarks are presented to summarize and amplify the discussion conducted during such interview. During such interview, the rejections of the claims at issue as obvious over varying combinations of Dooley, Graushar or Weller and the '599 patent were discussed. No agreement was reached.

Claims 1-55 are pending and at issue in the present application. Claim 55 has been added and claims 23 and 36 have been amended by this response, wherein support is found, in part, at page 8, line 23 through page 9, line 7 for such amendments.

Applicants respectfully traverse the rejection of the claims at issue as obvious over varying combinations of Dooley, Graushar or Weller and the '599 patent.

Claim 1, and claims 2-22 and 55 dependent thereon, recite book production apparatus including a gathering line operable during a single, continuous production sequence and a demand printer operable during the single production sequence for producing first and second different printed pages in response to print commands issued during the production sequence. The demand printer prints customized content on at least a portion of at least one of the pages without limitation as to position and orientation of the customized content over an entire surface of the at least one page. A feeding device is operable to feed the printed pages to the gathering line and a controller coordinates simultaneous issuance of the print command to the demand printer and operation of the gathering line, the demand printer, and the feeding device during the single production sequence to produce books.

Claim 23, and claims 24-35 and 43-48 dependent thereon, specify print production apparatus including a gathering line operable during a production sequence and a demand printer for producing first and second pages each having customized content that is disposed in an orientation at a position on a surface thereof. The first and second pages are printed during a time interval during which the gathering line is continuously moving. The demand printer includes means for printing the customized content on a least a portion of each page. A feeding device is operable to feed the customized pages to the gathering line and a controller coordinates operation of the gathering line, the demand printer, the feeding device, and timing of the demand printer during the production

PAGE 14/18 * RCVD AT 5/17/2007 1:59:00 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/13 * DNIS:2738300 * CSID:3122633990 * DURATION (mm-ss):06-44

sequence to produce customized books.

Claims 36-42 and 49-54 recite a method of producing books including the step of supplying a gathering line, a demand printer for producing first and second pages at least one of which has customized content printed on at least a portion thereof in response to print commands generated during a continuous production sequence, and further including the step of supplying a feeding device. The method also includes the step of coordinating simultaneous operation of the gathering line, the demand printer, the feeding device, and timing of the demand printer during a production sequence to produce the books.

None of the art cited by the examiner discloses or suggests a book production apparatus including a demand printer operable during the single production sequence to produce different printed pages in response to print commands issued during a single continuous production sequence, wherein the demand printer prints customized content on at least a portion of at least one of the pages without limitation as to position and orientation of the customized content over an entire surface of the at least one page together with a controller that coordinates simultaneous issuance of the print commands to the demand printer and operation of a gathering line, the demand printer, and a feeding device during the single production sequence, as recited by claims 1-22 and 55.

Further, none of the prior art cited by the examiner discloses or suggests a book production apparatus including a demand printer for producing first and second different pages each having customized content that is disposed in an orientation at a position on a surface thereof, wherein the first and second pages are printed during a time interval during which a gathering line is continuously moving and wherein the demand printer includes means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page together with a controller that coordinates operation of the gathering line, the demand printer, a feeding device, and timing of the demand printer during a production sequence to produce customized books, as recited by claims 23-35 and 43-48, as amended.

Still further, none of the art cited by the examiner discloses or suggests a method of producing books including the step of supplying a demand printer for producing first and second pages wherein at least one of the pages has customized content printed on at least a portion thereof

PAGE 15/18 * RCVD AT 5/17/2007 1:59:00 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/13 * DNIS:2738300 * CSID:3122633990 * DURATION (mm-ss):06-44

without limitation as to position and orientation of the customized content over an entire surface of the at least one page together with the step of coordinating simultaneous operation of a gathering line, the demand printer, a feeding device, and timing of the demand printer during a production sequence to produce books. These steps are recited by claims 36-42 and 49-54, as amended.

In fact, each of Dooley, Graushar, and Weller discloses the use of customization printers that are fixed in position during a print job. While these customization printers may be movable (i.e., repositionable) between print jobs, it is clearly the case that each of these customization printers is capable of printing in only a selected position and orientation during a particular print job, and none of these customization printers is capable of printing without limitation as to position and orientation of customized content over an entire surface of a printed page in response to print commands issued or generated during a production sequence. The '599 patent discloses controlling an electronic press to print fixed and variable information. However, the '599 patent does not teach coordinating the simultaneous operation of a gathering line, a demand printer that is capable of printing without limitation as to position and orientation of customized content over an entire surface of a page, and a feeding device during a production sequence. It also would not have been obvious to include the electronic press of the '599 patent in the systems of Dooley, Graushar, or Weller. In particular, the controllers of Dooley, Graushar, and Weller are programmed to control a printer that prints in a particular position and orientation, wherein the position and orientation can only be changed by shutting down the systems thereof. The controllers of Dooley, Graushar, or Weller would not be capable of coordinating a press such as that of the '599 patent that can print in different positions and orientations with the systems of Dooley, Graushar, and Weller because there is no disclosure or suggestion in Dooley, Graushar, and Weller as to how the controllers disclosed therein could communicate with the press of the '599 patent. Further, the controller of the '599 patent is only programmed to control the demand printer thereof and not a gathering line and/or feeding devices. The substitution of the demand printer and controller of the '599 patent for the printer of Dooley, Graushar, or Weller would not be trivial. In particular, the controller of the '599 patent would not be able to synchronize the demand printer with the gathering line and/or feeding devices.

Controlling of the timing of the demand printer is discussed, in part, at page 9, lines 1-7 of the present application as follows:

PAGE 16/18 * RCVD AT 5/17/2007 1:59:00 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/13 * DNIS:2738300 * CSID:3122633990 * DURATION (mm-ss):06-44

> The content of each signature is based on the customer date 102. The mail sequencing file transmitted over the one or more lines 104 in FIG. 8 determines the timing of the variable print engine 106. There may be additional time required to print one or more signatures if the customer data 102 are complex. In such a case, the controller 100 orders a variable signature earlier in the production sequence so that the signature can be produced in time to meet the other book components at the proper place on the gathering line. (Page 9, lines 1-7).

The systems of the '599 patent, Dooley, Graushar, and Weller do not disclose or suggest that such systems are capable of printing complex pages and therefore do not need a controller that can coordinate the timing of the demand printer with other components of the system to create books. In contrast, as noted above, the apparatus and method of claims 23-54 of the present application specify coordinating of operation of the demand printer, the gathering line, and the feeding devices with the timing of the demand printer because the time needed to print signatures may differ from signature to signature. Therefore, the feeding devices and the gathering line must be properly coordinated with the demand printer and the timing thereof to properly assemble books.

In an obviousness inquiry, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 682 (Fed. Cir.1990). The motivation to combine prior art to solve a problem may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself. *Dyster Textilefarben GMBH v. C.H. Patrick Co.*, 464 F.3d 1356, 1361 (Fed. Cir. 2006). The Supreme Court has held that the teaching, suggestion, motivation (TSM) test should not be strictly applied. *KSR Int'l Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745, at *32 (Apr. 30, 2007). However, the Court also noted that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *Id.* at *37. Instead, "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *Id.* at *38.

PAGE 17/18 * RCVD AT 5/17/2007 1:59:00 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/13 * DNIS:2738300 * CSID:3122633990 * DURATION (mm-ss):06-44

None of the cited references suggests that it would be feasible to achieve the degree of variability contemplated by the claimed subject matter, and there is simply no motivation to combine the features of the references to implement a book production apparatus or method as recited by claims 1-22 and 55. Furthermore, at least a reasonable expectation of success in combining prior art references is required to render an invention obvious. *In re Merck & Co.*, 800 F.2d 1091, 1096 (Fed. Cir.1986). There is no suggestion that a combination of any of Graushar, Dooley, or Weller with the '599 patent would have successfully resulted in a gathering line, a demand printer that is capable of printing without limitation as to position and orientation of customized content over an entire surface of a page, and a feeding device all operable during a single production sequence. Therefore, it follows that the claimed subject matter is not rendered obvious by the cited art.

In addition, because the cited references fail to disclose or suggest at least one element of each of claims 23-54, it follows that such claims are not obvious thereover.

For the foregoing reasons, reconsideration and withdrawal of the rejections of the claims and allowance thereof are respectfully requested.

Respectfully submitted,

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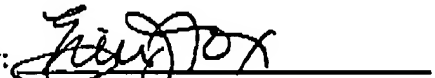
By: 
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PAGE 18/18 * RCVD AT 5/17/2007 1:59:00 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/13 * DNIS:2738300 * CSID:3122633990 * DURATION (mm-ss):06-44